

REMARKS

The Examiner noted that claims 1-29 and 32-40 were pending. Applicant has amended claims 1-3, 5, 6, 10-12, 14-17, 19-20, 23-29, 32, 34, and 36-40, and claims 1, 15, 27, 32, and 40 as independent claims. All of the amended claims conform to United States Patent and Trademark Office rules and do not add new matter to the application.

Support for a “concentrated, medial and posterior traction member” that provides “concentrated, medial and posterior pressure” (claims 1-29); and a “concentrated, medial and posterior traction strap” that provides “concentrated, medial and posterior pressure” (claims 32-40) is found, *e.g.*, on page 7, lines 27-32; page 8, lines 1-4; page 9, lines 16-18; and page 10, lines 2-21 of the Specification; and Figs. 1 and 2a-2c.

Applicant submits that none of these claims are either taught or suggested by the prior art. Applicant therefore requests that the Examiner renew examination of, and allow, these claims as amended, which Applicant respectfully submits are in condition for allowance as noted below.

Interview Summary

Applicant appreciates Examiners' willingness to conduct a telephonic interview, dated December 2, 2009, a summary of which follows generally:

- (1) Inventor Dean Cropper explains the fundamental change in approach to patella bracing represented by posterior tracking;
- (2) We discussed whether “active” was explicitly found in the specification, as opposed to “continuous and consistent[;]”
- (3) Examiner suggested possible use of the word “unobstructed” to define the “inward” member or strap, and/or the pressure exerted thereby;
- (4) We discussed “tracking” as it is defined in relevant medical literature, noting that it would not include the passive capabilities, if any, disclosed or suggested by the prior art references;
- (5) The Examiners asserted that Labour and Lehman are capable of performing the currently claimed structure; and
- (6) When asked, the Examiner did not comment on whether the previous Declaration of Christopher Powers, Ph.D. had been considered, but Examiners required that a relevant Declaration have all of the particular amended language-at-issue

Moreover, because (1) Applicant initiated the December 2, 2009 interview, (2) did not receive an interview summary from the Examiner at the time of the interview, and (3) has still not yet

received an interview summary from the Examiner, Applicant herein fully summarizes the interview by noting the following in accordance with 37 C.F.R. 1.133(b):

A) A brief description of the nature of any exhibit shown or any demonstration conducted:

Not applicable

(B) Identification of the claims discussed:

Applicant's representative and the Examiner generally discussed the independent claims.

(C) Identification of specific prior art discussed:

U.S. Pats. Nos. 3,804,084 ("Lehman") and 4,445,505 ("Labour")

(D) Identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner:

Regarding the independent claims, Applicant and Examiner discussed support for "active" as opposed to explicit language such as "consistent and continuous[.]" Please see point (3) above, as well.

(E) The general thrust of the principal arguments of the applicant and the examiner should also be identified, even where the interview is initiated by the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.

Please see points (1), (2) (4) and (6) above.

(F) A general indication of any other pertinent matters discussed:

None

(G) If appropriate, the general results or outcome of the interview; and

No agreement as to claim language was reached, but the Examiners agreed to review any Declarations and evidence of the medical meaning of "tracking" as made available in Applicant's future written response to the Examiner's Office action.

(H) In the case of an interview via electronic mail, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form, PTOL 413, is entered.

Not applicable

Objections to the Specification

The Specification was objected to allegedly for not providing antecedent basis for the claimed subject matter. Without prejudice or disclaimer on this issue, Applicant respectfully requests that the Examiner withdraw this objection in view of foregoing claim amendments.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-3, 4, 5, 10-12, 15, 17, 19, 20, 23-29, 32, 34 and 36-40 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Without prejudice or disclaimer on this issue, Applicant respectfully requests that the Examiner withdraw this objection in view of foregoing claim amendments.

Rejections under 35 U.S.C. § 102

Neither Labour nor Lehman anticipates the claims because they:

- (1) do not necessarily teach at least one of the structural limitations recited within claims 1, 15, 27, 32 or 40, and indeed**
- (2) cannot perform these limitations' recited functions.**

Labour

Claims 1-3, 5-8, 13-17, 19-21, 26-29, 32 and 36-37 were rejected as being anticipated by United States patent number 4,445,505 ("Labour").

Applicant respectfully submits, however, that the Examiner allow the claims as amended at least for the following reasons:

Labour does not explicitly teach the following illustrative limitations of these claims:

a concentrated, medial and posterior traction member that operatively fits over, and provides concentrated, medial and posterior pressure against, the patella; wherein the concentrated, medial and posterior traction member provides a compressive force against the patella, thereby increasing the contact surface area between the patellofemoral articular tissue and an associated femoral trochlear groove.

Labour does not inherently teach the structural limitation, “concentrated medial and posterior traction member”, or its recited function, *i.e.*, in which it “provides concentrated, medial and posterior pressure” because these features are not *necessarily* present in Labour. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).” *Manual of Patent Examining Procedure* § 2112, IV, Eight Ed., August 2001, Latest Rev., August 2006 (“M.P.E.P.”) (*emphasis added*).

Thus, Labour’s strap 80 would not be recognized by one having ordinary skill in the art as being a “concentrated, medial and posterior traction member[.]”

As such, Applicant submits that the rejections are traversed with regard to Labour for all of the independent claims, which have either a concentrated, medial and posterior traction member or a concentrated, medial and posterior traction strap.

Lehman

Claims 1-8, 13-21, 26-29, 32-37 and 40 were rejected as being anticipated by United States patent number 3,804,084 (“Lehman”).

Applicant respectfully submits, however, that the Examiner allow the claims as amended at least for the following reasons:

Lehman does not explicitly teach the following limitations of these claims:

a concentrated, medial and posterior traction member that operatively fits over, and provides concentrated, medial and posterior pressure against, the patella;
wherein the concentrated, medial and posterior traction member provides a compressive force against the patella, thereby increasing the contact surface area between the patellofemoral articular tissue and an associated femoral trochlear groove.

Lehman does not inherently teach the structural limitation, “concentrated medial and posterior traction member”, or its recited function, *i.e.*, in which it “provides concentrated, medial and posterior pressure” because these features are not *necessarily* present in Labour. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of

ordinary skill. Inherency, however, may not be established by probabilities or possibilities. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).” *Manuel of Patent Examining Procedure* § 2112, IV, Eight Ed., August 2001, Latest Rev., August 2006 (“M.P.E.P.”) (*emphasis added*).

Thus, Lehman’s strip 90 would not be recognized by one having ordinary skill in the art as being a “concentrated medial and posterior traction member[.]”

As such, Applicant respectfully submits that the rejections are traversed with regard to Lehman for all of the independent claims, which have either a concentrated, medial and posterior traction member or a concentrated, medial and posterior traction strap.

Rejections under 35 U.S.C. § 103

Neither Labour nor Lehman inherently teach the limitations missing from Cawley or Lamping

Labour in view of Cawley

Claims 4, 9-12, 18, 22-25, 33-35 and 38-40 were rejected as being obvious over Labour in view of United States patent number 6,551,264 (“Cawley”) and/or Lehman.

Claims 9-12, 22-25, 38 and 39 were rejected as being obvious over Labour in view of Cawley

At least in view of the above-recited reasoning, however, Applicant respectfully submits that all of these claims are in condition for allowance. In short, none of Labour, Lehman or Cawley teaches or suggests, either inherently or explicitly, a concentrated, medial and posterior traction member (or a concentrated, medial and posterior traction strap), at least one of which is a structural element in independent claims 1, 15, 27, 32 and 40. *Moreover, the art is replete with evidence that teaches away from the use of a concentrated, medial and posterior traction member (or a concentrated, medial and posterior traction strap). Nearly every, if not every, knee brace in the prior art - in some way, shape, or form - teaches a protective nest or opening about the wearer’s patella.*

Labour or Lehman in view of Lamping

Claim 13 was rejected as being obvious over Labour (or alternately Lehman) in view of United States patent number 6,485,448 (“Lamping”)

At least in view of the above-recited reasoning, however, Applicant respectfully submits that all of these claims are in condition for allowance. In short, none of Labour, Lehman or Lamping teaches or suggests, either inherently or explicitly, a concentrated, medial and posterior traction member (or a concentrated, medial and posterior traction strap), at least one of which is a structural

element in independent claims 1, 15, 27, 32 and 40. *Moreover, the art is replete with evidence that teaches away from the use of a concentrated, medial and posterior traction member (or a concentrated, medial and posterior traction strap). Nearly every, if not every, knee brace in the prior art - in some way, shape, or form - teaches a protective nest or opening about the wearer's patella.*

Date of Applicant's actual reduction to practice

Applicant also refers the Examiner to the Declaration of Dean E. Cropper under 37 CFR § 1.131, submitted June 1, 2007, in which Applicant hereby shows actual reduction to practice, prior to March 29, 2002, of subject matter covered by all of independent claims 1, 15, 27, 32 and 40.

At least for all of the forgoing reasons, Applicant respectfully requests that the examiner reexamine and allow all of claims 1-29 and 32-40.

Respectfully submitted,

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